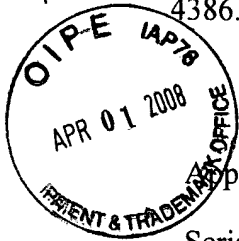


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AFIN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Kuramori et al.
Serial No.: 10/531,374
Conf. No.: 1233
Filed: April 15, 2005
For: TIRE WHEEL ASSEMBLY

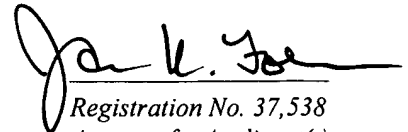
Art Unit: 3617

Examiner: Kotter, Kip T.

I hereby certify that this paper is being deposited with the United States Postal Service as FIRST-CLASS mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this date.

March 21, 2008

Date


Registration No. 37,538
Attorney for Applicant(s)

TRANSMITTAL

Mail Stop APPEAL BRIEF-PATENTS
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Transmitted herewith is a communication regarding the above-identified application.

- (X) Appellant's Reply to Examiner's Answer Under 37 C.F.R. 41.41.
- (X) The Commissioner is hereby authorized to charge any additional fees which may be required to this application under 37 C.F.R. 1.16-1.17, or credit any overpayment, to Deposit Account No. 07-2069. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 07-2069. A duplicate copy of this sheet is enclosed.
- (X) If a Petition under 37 C.F.R. 1.136(a) for an extension of time for response is required to make the attached papers timely and does not separately accompany this transmittal, Applicant hereby petitions under 37 C.F.R. 1.136(a) for an extension of time for response in the above-identified application for the period required to make the attached response timely.

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Respectfully submitted,
GREER, BURNS & CRAIN, LTD.

By


James K. Folker
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386.77660

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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March 21, 2008

Date

James K. Folker
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APPELLANT'S REPLY TO EXAMINER'S ANSWER UNDER 37 C.F.R. 41.41

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0941.68751

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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March 21, 2008

Date

[Signature]
Registration No. 37, 538
Attorney for Applicant(s)

APPELLANT'S REPLY TO EXAMINER'S ANSWER UNDER 37 C.F.R. 41.41

Mail Stop APPEAL BRIEF-PATENTS
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is in response to the Examiner's Answer dated January 24,
2008.

REBUTTAL TO EXAMINER'S
RESPONSE TO APPLICANTS' ARGUMENT

On page 4 (lines 6-8) of the Examiner's Answer, the Examiner responded to Applicants' argument that the structure of the run flat insert of the Payne et al. reference is so different from the structure of the insert of Hellweg et al., that the mounted and unmounted widths of Payne et al. are irrelevant to Hellweg et al. by asserting that "the test for obviousness is not whether the features of the secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA) 1981)."

In response, Applicants agree with the Examiner's statement of the holding of the case of *In re Keller*. However, Applicants respectfully submit that although bodily incorporation of an element of the secondary reference into the primary reference is not required, when a specific dimensional relationship taken from a component of the secondary reference is relied upon, that component of the secondary reference should have a very high degree of structural similarity to the component of the primary reference that is being modified according to the dimensional relationship.

Applicants assert that member 60 of Payne et al. does not have the necessary level of structural similarity to member 3 of Hellweg et al. to use dimensions from Payne et al. to modify this component of Hellweg et al. For example, the cross-

sections of the two members are very different. As can be seen in Figures 1 and 11 of Payne et al., member 60 has a relatively flat outer surface 62 in cross-section. In contrast, as can be seen in Figure 1 of Hellweg et al., the cross-section of member 3 includes a central concave portion surrounded by a pair of convex portions. Accordingly, any forces applied to member 3 of Hellweg et al. will be distributed in a very different manner than when the same forces are applied to member 60 of Payne et al. More specifically, column 8 (lines 33-40) of Payne et al. describes how the forces start at the central portion 62 and spread outwardly to the leg portions, while in Hellweg et al. the forces start at the crowns of both convex portions and spread both inwardly towards the other convex portion and outwardly towards the leg portions.

Other structural differences between the device of Hellweg et al. and that of Payne et al. also contribute to different pressure distributions. For example, member 3 of Hellweg et al. is supported by a stack of elastomeric supporting members 4 and 5 of varying elasticity, while Payne et al. lacks such support members. Further, the ends of the legs of member 3 of Hellweg et al. are shaped differently than the ends of the legs of member 60 of Payne et al. Due to these different pressure distributions, Applicants respectfully submit that one of ordinary skill in the art would not have assumed that the desired amount of compression for member 60 of Payne et al. was the same as that for member 3 of Hellweg et al. Accordingly, in light of all of these structural differences, and others, Applicants respectfully submit that one of ordinary skill in the art would not have imported the dimensions for the mounted and unmounted widths from Payne et al. into the device of Hellweg et al.

On page 6 of the Examiner's Answer, the Examiner responds to Applicants' argument that "the specific widths of Payne et al. asserted by the Examiner are not the same as the claimed widths W1 and W2, but are instead measurements of the widths of a different interval" by once again asserting that the secondary reference need not be bodily incorporated into the primary reference (page 6, lines 1-5) and by asserting that the Hellweg et al. reference discloses that the flexibility and elasticity of the ring shaped support elements can be adjusted (page 6, lines 6-16).

In response, Applicants once again acknowledge that bodily incorporation is not required. However, where the Examiner is taking exact dimensions from a component of one reference under two different conditions (mounted and unmounted), and then applying those exact dimensions to a component of another reference to arrive at a claimed relationship between those dimensions, the endpoints of those dimensions of the secondary reference need to be the same as the endpoints of the primary reference. Otherwise, different intervals are being considered with respect to the different references, as explained in detail in Section I(A)(ii) on pages 12-14 of Appellants' Brief. Additionally, in response to the Examiner's assertion about adjusting the flexibility and elasticity, Applicants note that this portion of the Hellweg et al. reference was referring to the support elements (such as support elements 4 and 5 of Figure 1 of Hellweg et al.), and not to the annular shell 3. Accordingly, for at least the reasons set forth in Appellants' Brief on pages 12-14, Applicants respectfully request the withdrawal of the §103 rejection of Claim 1.

On page 8 (line 16) through page 9 (line 10) of the Examiner's Answer, the Examiner quotes MPEP §2144.05 for the proposition that a *prima facie* case of obviousness exists where there is no overlap between the claimed and prior art ranges, if the claimed value is close enough to the prior art values that one of ordinary skill in the art would have expected the same properties. Applicants agree that the Examiner has correctly stated this legal proposition. But, in response, Applicants assert that this proposition is not applicable to the facts at hand because, *inter alia*, the structure of the component from which the Examiner acquired the dimensions for the range is different from the structure of the primary reference and the present invention, as discussed above and in Section I(A)(i) of Appellants' Brief, and the interval upon which the range is based in the secondary reference is also different from that of the primary reference and the present invention, as discussed above and in Section I(A)(ii) of Appellants' Brief. Thus, even though the actual numbers may be close to the claimed range, the physical measurements that the numbers represent are different. Accordingly, Applicants respectfully submit that this proposition does not support maintaining the §103 rejection either.

On page 11 (lines 9-15 of the Examiner's Answer, the Examiner asserts that Applicants have admitted that elastic rings with a JIS hardness of 50-65 are old and obvious. In response, Applicants would like to clarify that no such admission has been made. Further, Applicants would also like to clarify that although Applicants may not have specifically responded to every one of the Examiner's assertions, such lack of a

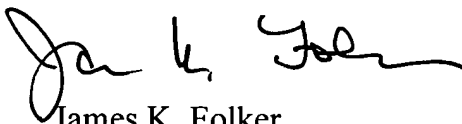
specific response should not be taken as an admission, but is merely due to the fact that Applicants have focused on certain portions of the Examiner's rejection.

CONCLUSION

For the reasons discussed above, as well as for the reasons discussed in Appellants' Brief, filed November 19, 2007, Applicants respectfully request that the Board of Patent Appeals and Interferences reverse the §103 rejection of Claim 1 under Hellweg et al. in view of Payne et al. and Boiocchi et al.

Respectfully submitted,

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March 21, 2008

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